TOHTONKU SDN. BHD.

v.

SUPERACE (M) SDN. BHD.

SUPREME COURT, KUALA LUMPUR
MOHD. YUSOFF MOHAMED SCJ
HARUN HASHIM SCJ
AJAIB SINGH SCJ
[CIVIL APPEAL NO. 02-63-1989]
20 MARCH 1992

CIVIL PROCEDURE: *Ex parte order - Whether provisional order and liable to be set aside by the Court.*

TRADEMARKS: *Infringement - Whether there was infringement of appellant's trade mark - Registered proprietor of goods - Exclusive right to use of trade mark - Question of similarity between two productions - Whether resemblance likely to deceive or cause confusion to ordinary purchasers.*

This was an appeal against the decision of the learned trial Judge who held on the preliminary issue, that the intervener had a direct interest in the matter and would therefore be allowed to intervene in these proceedings. On another preliminary issue the learned trial Judge also held, that an *ex parte* order was always a provisional order and that being so is always liable to be set aside by the Court on the application of any person who is affected by the order.

Held:

[1] The learned trial Judge had found that "there are two features of the two marks which are similar, namely red in colour and split in wording".

[2] However having regard to the totality of the circumstances of the case the learned Judge was satisfied that there is no similarity between the two products as when "considering the appearances of the two marks together with their features, it is not likely that ordinary purchasers would be deceived into regarding the intervener's product to be the product of the applicant".

[3] In the premises the appellant's rights in respect of their trade mark "Mister" had not been infringed.

[Appeal dismissed.]

[**Bahasa Malaysia** Translation of Headnote]

PROSEDUR SIVIL: *Perintah ex-parte - Samada perintah sementara dan samada boleh diketepikan oleh Mahkamah.*

TANDA NIAGA: *Pelanggaran - Samada berlaku pelanggaran hak terhadap tanda niaga perayu - Peniaga berdaftar barangan - Mempunyai hak istimewa untuk kegunaan tanda niaga itu - Soal persamaan di antara dua barangan - Samada gambaran yang sama boleh perdayakan atau menimbulkan keraguan pada pembeli biasa.*

Ini adalah satu keraguan terhadap keputusan yang Arif Hakim pembicaraan yang telah memutuskan atas isu permulaan, bahawa intervener ada kepentingan langsung dalam perkara tersebut dan hendaklah dibenarkan untuk intervene dalam prosiding ini. Dalam satu lagi isu

permulaan, Yang Arif Hakim juga putuskan bahawa, perintah *ex-parte* adalah pada asasnya perintah sementara dan oleh itu perintah tersebut boleh diketepikan oleh Mahkamah melalui permohonan yang dibuat oleh mana-mana orang yang tertakluk pada perintah itu.

Diputuskan:

[1] Yang Arif Hakim pembicaraan mendapati "ada dua jenis ciri kedua-dua tanda yang sama iaitu berwarna merah dan pecahan dalam perkataan".

[2] Tetapi, setelah ambil kira semua peristiwa dan keadaan guaman itu, Yang Arif puashati bahawa tidak ada persamaan diantara kedua-dua barangan itu, apabila "mengambil kira gambaran kedua tanda secara bersama dengan ciri-ciri, ianya tidak akan perdayakan pembeli biasa dengan kepercayaan bahawa barangan intervener itu adalah barangan pemohon juga."

[3] Maka tidak berlaku pelanggaran terhadap hak tanda niaga perayu iaitu tanda niaga "Mister" tersebut.

[Rayuan ditolak.]

Cases referred to:

Pegang Mining Co. Ltd. v. Choong Sam & Ors. [1969] 2 MLJ 52 ***(foll)***
Hille International Ltd. v. Tiong Hin Engineering Pte. Ltd. [1983] CLJ (Rep) 1002 ***(cit)***
Jordache Enterprises Inc. v. Millennium Pte. Ltd. [1985] 1 MLJ 281 ***(cit)***
Chong Fok Shang & Anor. v. Lily Handycraft & Anor. [1989] 1 CLJ (Rep) 424 ***(dist)***
The Pianotist Co. Ltd. [1906] 23 RPC 774 ***(foll)***

Legislation referred to:

Trade Description Act 1972, s. 16
Trade Marks Act 1976, ss. 35, 38

For the appellant - Muhammad Shafee Abdullah (Peter Huang with him); M/s. Peter Huang & Associates
For the respondent - Choy Kam Lee (K.C. Lai with him); M/s. K.C. Lai & Co.

JUDGMENT

Mohd. Yusoff Mohamed SCJ:

This is an appeal against the decision of the learned trial Judge who held, on the preliminary issue, that the intervener had a direct interest in the matter and should therefore be allowed to intervene in these proceedings. The learned trial Judge also held, on another preliminary issue, that an *ex parte* order is always a provisional order and that being so is always liable to be set aside by the Court on the application of any person who is affected by the order.

It is settled law, on the authorities, that a party may be added if his "legal interests" will be affected by the judgment in the action but not if his commercial interests alone would be affected: per Lord Diplock in *Pegang Mining Co. Ltd. v. Choong Sam & Ors.* [1969] 2 MLJ 52 @ pp. 55-56. In that case, the Privy Council had formulated the test to determine whether a party's interests in the matter are "legal" or merely "commercial" in the following words (at p. 56):

> A better way of expressing the test is: will his rights against or liabilities to any party to the action in respect of the subject matter of the action be directly affected by any order which may be made in this action?

The answer to that question, as far as the interveners in this case are concerned, are definitely in the affirmative. We therefore hold that the learned trial Judge was correct in his decision on this point.

With regard to the merits of the case, the principal issue before the learned trial Judge was whether the trade mark of the appellant had been infringed by the intervener. Under s. 35 of the Trade Marks Act 1976 the registered proprietor of a trade mark in respect of any goods has the exclusive right to the use of the trade mark in relation to those goods.

Under s. 16 of the Trade Description Act, where any registered proprietor or registered user of any trade mark finds that his rights in respect of such trade mark has been infringed, he may apply for an order declaring such infringing trade mark to be a false trade description for the purposes of this Act.

Under s. 38 of the Trade Marks Act, a registered trade mark is infringed by a person who uses a mark which:

(a) is identical with it; or

(b) so nearly resembling it as is likely to deceive; or

(c) so nearly resembling it as is likely to cause confusion.

On the evidence, the learned trial Judge had held that the appellant's goods and the intervener's goods were not identical. On the question of resemblance and likelihood of deception, the learned Judge said that, having regard to "not only the whole mark" but also to their "distinguishing or essential features", he was satisfied that:

> It is not likely ordinary purchasers would be deceived into regarding the intervener's product to be the produce of the applicant.

Having so found that the appellant's rights have not been infringed, the learned Judge consequently held that the appellant was not entitled to the order made under s. 16 of the Trade Description Act 1972.

In their submissions during the hearing of their appeal to this Court, Counsel for the appellant had cited several authorities in support of their arguments, including *Hille International Ltd. v. Tiong Hin Engineering Pte. Ltd.* [1983] CLJ (Rep) 1002, *Jordache Enterprises Inc. v. Millennium Pte. Ltd.* [1985] 1 MLJ 281 and *Chong Fok Shang & Anor. v. Lily Handycraft & Anor.* [1989] 1 CLJ (Rep) 424.

In *Hille International*, the plaintiffs were the registered proprietor of a trade mark "hille" in respect of their product (prolypropylene chair shells) since 1968. The defendants came out with a similar product under the brand name "CILLY'. The learned trial Judge, Rajah J held (at p. 1004) that:

> I am satisfied that on the evidence before me ... the defendants deliberately invented the word "CILLY" to deceive and cause confusion in the trade.

The Court, however, held that there was no passing-off as the colors and shapes used in the manufacture of the product was common to the trade.

In *Jordache*, the appellants were the registered proprietors of the trade mark "Jordache" in respect of men's and women's jeans. In May 1982, they appointed a sole agent in Singapore to distribute their product in Singapore. Whilst preparations were going on, but before they could launch their product, the defendants came out with their product under the unregistered trade mark "Jordane". The learned trial Judge, Thean J held (at p. 283) that:

> Looking at and listening to the two names "Jordache" and "Jordane", I ineluctably arrive at a conclusion that one so closely resembles the other as to be likely to deceive or cause confusion in the course of trade ...

Consequently, the defendants had infringed the plaintiffs' trade mark. The Judge, however, held that the plaintiffs had failed to establish their claim for passing off.

In Chong Fok Shang, the plaintiffs were the registered proprietors of the trade mark "Minlon" in respect of their product (knitting yarns). The defendants were manufacturers of a similar product, which they marketed in 1986 under the trade "Winlon". The learned trial Judge, Wan Adnan J, held (at pp. 426-427):

> The question is ... whether the mark "Winlon" used by the defendants so nearly resembles the plaintiffs' trade mark "Minlon" as to be likely to deceive or cause confusion ...
>
> Using the tests which I have earlier referred to and judging from the sound and appearance of the two words "Minlon" and "Winlon" I find that the defendants' mark "Winlon" so nearly resembles the plaintiffs' trade mark "Minlon" as to be likely to deceive or cause confusion. I also find that the mark "Winlon" used by the defendants would lead persons of average intelligence into accepting the knitting yarns of the defendants as and for the knitting yarns of the plaintiffs.

The "tests" which Wan Adnan J was referring to were contained in Parker J's judgment in *The Pianotist Co. Ltd.* [1906] 23 RPC 774, in the following terms:

> You must take the two words. You must Judge them, both by their look and their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those marks are used in a normal way as a trade mark of the goods of the respective owners of the marks.

In the instant case, the learned trial Judge had found that "there are two features of the two marks which are similar, namely, red in colour and split in wording." However, having regard to the totality of the circumstances of the case, the learned Judge was apparently satisfied that:

> there is no similarity between the two words 'MISTER' and 'SISTER' as to be likely to cause deception or confusion. The words are different. There is similarity in the second syllable but as a whole the similarity is not close enough as to be likely to cause deception or confusion. Further, the get-up of the intervener's product is green background colour with the picture of a lady whereas the get-up of the applicant's product is white-blue-grey background colour with the picture of a lady and a man.

We are in agreement, having regard to the "tests" as mentioned by Wan Adnan J in *Chong Fok Shang*, citing with approval Parker J's judgment in the *The Pianotist Co. Ltd.*, the trial Judge was correct when he concluded that:

> Applying the above test and considering the appearance of the two marks together with their features I find that it is not likely that ordinary purchasers would be deceived into regarding the intervener's product to be the product of the applicant.

In the premises, we hold that the appellant's rights in respect of their trade mark 'MISTER' had not been infringed and their appeal must be dismissed.

Also found at [1992] 2 CLJ 1153